



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

AMD-MKE  
C/O FOLEY LARDNER LLP  
777 EAST WISCONSIN AVENUE  
MILWAUKEE WI 53202-5306

**MAILED**  
**MAY 26 2009**  
**OFFICE OF PETITIONS**

In re Patent No. 7,462,549	:
Xiang et al.	:
Issue Date: December 9, 2008	:
Application No. 10/755602	:
Filed: January 12, 2004	:
Attorney Docket No.	:
039153-0693 (H1718)	:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed February 6, 2009. This matter is being properly treated under 37 CFR 1.705(d) as an application for patent term adjustment.

The application for reconsideration of patent term adjustment is **DISMISSED**.

The above-identified application matured into U.S. Patent No. 7,462,549 on December 9, 2008. The patent issued with a patent term adjustment of 216 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See, 37 CFR 1.705(d). Patentees request that the patent term adjustment determination for the above-identified patent be changed from 216 days to 427 days.

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays occur on the same day.

The copy of the "Patent Term Adjustment Calculation System" printout submitted by patentees sets forth a period of

adjustment for Office delays totaling 911 days (Three Year Delay under 37 CFR 1.703(b) of 697 days plus a period of adjustment due to examination delay pursuant to 37 CFR 1.702(a) of 214 days). The printout also sets forth an overlap of 157 days. The printout also reflects a reduction of patent term adjustment totaling 484 days for applicants' failure to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. Thus, patentees assert entitlement to an overall adjustment of 427 days (911 days for Office delays less 484 days for applicants' delays).

Patentees' printout acknowledges the adjustments under 37 CFR 1.702(a) totaling 371 days. Patentees' printout also acknowledges the reductions for applicants' failure to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. These reductions total 481 days. It is noted that patentees' own calculation of the period of reduction in connection with the amendment under 37 CFR 1.312, filed June 18, 2008, errantly sets forth a reduction of 123 days. The correct reduction in this regard is 120 days. See, 37 CFR 1.704(c)(10)(ii).

Under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704.

The Office agrees that as of the issuance of the patent on December 9, 2008, the application was pending three years and 697 days after its filing date. The Office agrees that because certain actions were not taken within specified time frames, the patent is entitled to an adjustment of 371 days pursuant to 37 CFR 1.702(a). At issue is whether patentees should accrue an additional 697 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 371 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 371 days overlap. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 35 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See, 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See, Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule, 65 Fed. Reg. 56366 (Sept. 18, 2000). See, also, Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See, also, Explanation of 37 CFR 1.703(f) and of the United States Patent and

Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A),  
69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of Patentees. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding § 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3-year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154(b)(1)] are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not

be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718<sup>1</sup>

As such, the period for over three-year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames. In other words, consideration of the overlap does not begin three years after the filing date of the application.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, January 12, 2004, to the date the patent issued on December 9, 2008. Prior to the issuance of the patent, 371 days of patent term adjustment were accorded for the Office failing to respond within specified time frames during the pendency of the application. The 371 days accorded pursuant to 37 CFR 1.702(a) overlap with the 697 days of Office delay under 37 CFR 1.702(b).

The application actually issued three years and 697 days after its filing date. The Office did not delay 371 days and then delay an additional 697 days. Accordingly, 697 days of patent term adjustment (not 371 days and 697 days) was properly entered because the period of delay of 697 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 371 days attributable to grounds specified in § 1.702(a). Entry of both periods is not warranted. Thus, 697 days, which includes the 371 days pursuant to 37 CFR 1.702(a), is determined to be the actual number of days that the issuance of the patent was delayed.

Accordingly, at issuance, the Office properly entered an overall adjustment of 697 days of patent term adjustment for the Office taking in excess of three years to issue the patent.

---

<sup>1</sup> The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106<sup>th</sup> Cong. 1<sup>st</sup> Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999) (daily ed. Nov. 17, 1999).

In view thereof, no adjustment to the patent term will be made because the correct adjustment of 216 days is properly set forth in the Letters Patent (adjustments totalling 697 days less reductions totalling 481 days).

The Office acknowledges submission of the required \$200.00 application fee. See, 37 CFR 1.18(e).

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods, at (571) 272-3232.

A handwritten signature in black ink, appearing to read 'Alesia Brown', with a stylized, flowing script.

Alesia Brown  
Petitions Attorney  
Office of Petitions